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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,076	01/10/2002	Osamu Nagai	P67506US0	1981
136	7590	02/20/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,076	NAGAI ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 with broadest independent claim 1 as the main invention is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04 September 2002</u> . | 6) <input type="checkbox"/> Other: ____ |

This application is before the examiner for consideration on the merits.

I. The application has been carefully studied. There are six groups of the claims (1-12, and 16-20), (13), (14), (15), (21) and (22) with broadest independent claim 1 as the main invention. They are not considered to be patentably different or distinct. Accordingly, no separate consideration and search is made. Should applicants show or urge otherwise in the next response to this Office action in order for it to be considered timely. A restriction will be made for the record as shown or urged.

II. An initial consideration and search has found about several dozens of references these disclose, teach and suggest the claimed invention at least on the broadest main invention claim 1. A set of from about 3 to 5 references will be next in line to be applied when each and all of the applied references in the applied set on the record are all overcome. The applied first set of references are those known and submitted by applicants.

III. The language "characterized in that...made of...said surface" (1) is and (2)(a) has been considered and searched as a product-by-process and (b) is given a little to no value since there is no evidence on the record that the claimed product-by-process is any better or unusual or unexpected result than any other making process. It is suggested, requested and required that applicants must test to provide an advantage or unusual or unexpected result for a patentability of a claim to overcome an applied reference.

Art Unit: 1752

IV. Applicants' prior art submission filed on 04 September 2002 has been considered to the extent of the English language being provided only.

V. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22 with broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 102(b) as being anticipated by Ozora ('746 as submitted. Applicants are required to provide and submit an English language equivalent no later than a filing appeal brief. Otherwise, the appeal brief will not be considered and dismissed. It is now notified for the record).

Ozora discloses and teaches a resin being cured on a surface part. Please see the English language portion as provided. Since Ozora discloses, and teaches the main and essential embodiments of the invention, the claims are found to be anticipated by Ozora.

VI. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 with broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Krasij et al (6,660,422), Ozora ('746) and Mizobi et al (EP '575 as submitted being equivalent to US 5,686,032).

Art Unit: 1752

Mizobi et al disclose, teach and suggest an electrochemical power having a proton exchange membrane and gaskets and sealants. Please see the whole disclosure of each of the applied references, especially in Mizabi at figures and their descriptions. The language "characterized in that...made of...said surface" (1) is and (2)(a) has been considered and searched as a product-by-process and (b) is given a little to no value since there is no evidence on the record that the claimed product-by-process is any better or unusual or unexpected result than any other making process. It is suggested, requested and required that applicants must test to provide an advantage or unusual or unexpected result for a patentability of a claim to overcome an applied reference. Ozora is cited to show an additional type of a gasket at the English language portion as submitted. Mizobi et al is cite to show additional types of gaskets and process of obtaining the gaskets...,especially at the figures and their descriptions and co.1:15 to 2:6 and 43 to 57, 3:42 to 4:3, 12:23-43, 45:1-7. Since the above references are related to an electrochemical power and gaskets, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite or include the known gaskets and their function for the advantage as disclosed, taught and suggested in the secondary references.

VII. Claims 1-22 with broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 102(b) as being anticipated by Kamiza et al ('220 as submitted. Applicants are required to provide and submit an English language equivalent no later than a filing appeal brief. Otherwise, the appeal brief will not be considered and dismissed. It is now notified for the record).

Kamiza et al disclose and teach a gasket or seal agent on a surface. Please see the

Art Unit: 1752

English language portion as provided. Since Kamiza et al disclose and teach the main and essential embodiments of the invention, the claims are found to be anticipated by Kamiza et al.

VIII. Claims 1-22 with broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Krasij et al (6,660,422), Kazami et al ('220) and Mizobi et al (EP '575 as submitted being equivalent to US 5,686,032).

Mizobi et al disclose, teach and suggest an electrochemical power having a proton exchange membrane and gaskets and sealants. Please see the whole disclosure of each of the applied references, especially in Mizabi at figures and their descriptions. The language "characterized in that...made of...said surface" (1) is and (2)(a) has been considered and searched as a product-by-process and (b) is given a little to no value since there is no evidence on the record that the claimed product-by-process is any better or unusual or unexpected result than any other making process. It is suggested, requested and required that applicants must test to provide an advantage or unusual or unexpected result for a patentability of a claim to overcome an applied reference. Kazami et al is cited to show an additional type of a gasket at the English language portion as submitted. Mizabi et al is cite to show additional types of gaskets and process of obtaining the gaskets...,especially at the figures and their descriptions and co.1:15 to 2:6 and 43 to 57, 3:42 to 4:3, 12:23-43, 45:1-7. Since the above references are related to an electrochemical power and gaskets, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite or include the known gaskets and their function for the advantage as disclosed, taught and suggested in the secondary references.

Art Unit: 1752

IX. Claims 1-22 with broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 102(b) as being anticipated by Uchida et al ('223 as submitted. Applicants are required to provide and submit an English language equivalent no later than a filing appeal brief. Otherwise, the appeal brief will not be considered and dismissed. It is now notified for the record).

Uchida et al disclose and teach a gasket on a surface. Please see the English language portion as provided. Since Uchida et al disclose and teach the main and essential embodiments of the invention, the claims are found to be anticipated by Uchida et al.

X. Claims 1-22 with broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Krasij et al (6,660,422), Uchida et al ('223) and Mizobi et al (EP '575 as submitted being equivalent to US 5,686,032).

Mizobi et al disclose, teach and suggest an electrochemical power having a proton exchange membrane and gaskets and sealants. Please see the whole disclosure of each of the applied references, especially in Mizabi at figures and their descriptions. The language "characterized in that...made of...said surface" (1) is and (2)(a) has been considered and searched as a product-by-process and (b) is given a little to no value since there is no evidence on the record that the claimed product-by-process is any better or unusual or unexpected result than any other making process. It is suggested, requested and required that applicants must test to provide an advantage or unusual or unexpected result for a patentability of a claim to overcome an applied reference. Uchida et al is cited to show an additional type of a gasket at the English language portion as submitted. Mizabi et al is cite to show additional types of gaskets and

Art Unit: 1752

process of obtaining the gaskets..., especially at the figures and their descriptions and co.1:15 to 2:6 and 43 to 57, 3:42 to 4:3, 12:23-43, 45:1-7. Since the above references are related to an electrochemical power and gaskets, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite or include the known gaskets and their function for the advantage as disclosed, taught and suggested in the secondary references.

XI. Claims 1-22 with broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuzaki et al ('987 as submitted. Applicants are required to provide and submit an English language equivalent no later than a filing appeal brief. Otherwise, the appeal brief will not be considered and dismissed. It is now notified for the record).

Matsuzaki et al disclose and teach a gasket or seal agent on a surface. Please see the English language portion as provided. Since Matsuzaki et al disclose and teach the main and essential embodiments of the invention, the claims are found to be anticipated by Matsuzaki et al.

XII. Claims 1-22 with broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Krasij et al (6,660,422), Matsuzaki et al ('987) and Mizobi et al (EP '575 as submitted being equivalent to US 5,686,032).

Mizobi et al disclose, teach and suggest an electrochemical power having a proton exchange membrane and gaskets and sealants. Please see the whole disclosure of each of the applied references, especially in Mizabi at figures and their descriptions. The language

Art Unit: 1752

"characterized in that...made of...said surface" (1) is and (2)(a) has been considered and searched as a product-by-process and (b) is given a little to no value since there is no evidence on the record that the claimed product-by-process is any better or unusual or unexpected result than any other making process. It is suggested, requested and required that applicants must test to provide an advantage or unusual or unexpected result for a patentability of a claim to overcome an applied reference. Matsuzaki et al is cited to show an additional type of a gasket at the English language portion as submitted. Mizabi et al is cite to show additional types of gaskets and process of obtaining the gaskets...,especially at the figures and their descriptions and co.1:15 to 2:6 and 43 to 57, 3:42 to 4:3, 12:23-43, 45:1-7. Since the above references are related to an electrochemical power and gaskets, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite or include the known gaskets and their function for the advantage as disclosed, taught and suggested in the secondary references.

XIII. Claims 1-22 with broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 102(b) as being anticipated by Mizobi et al (EP '575 as submitted being equivalent to US 5,686,032).

Mizabi et al disclose and teach a gasket on a surface and method for obtaining the gasket. Please see the whole disclosure of the applied references, especially at the figures and their descriptions and co.1:15 to 2:6 and 43 to 57, 3:42 to 4:3, 12:23-43, 45:1-7. Since Mizabi et al disclose and teach the main and essential embodiments of the invention, the claims are found to be anticipated by Mizabi et al.

Art Unit: 1752

XIV. Claims 1-22 with broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Krasij et al (6,660,422) and Mizobi et al (EP '575 as submitted being equivalent to US 5,686,032).

Mizobi et al disclose, teach and suggest an electrochemical power having a proton exchange membrane and gaskets and sealants. Please see the whole disclosure of each of the applied references, especially in Mizabi at figures and their descriptions. The language "characterized in that...made of...said surface" (1) is and (2)(a) has been considered and searched as a product-by-process and (b) is given a little to no value since there is no evidence on the record that the claimed product-by-process is any better or unusual or unexpected result than any other making process. It is suggested, requested and required that applicants must test to provide an advantage or unusual or unexpected result for a patentability of a claim to overcome an applied reference. Matsuzaki et al is cited to show an additional type of a gasket at the English language portion as submitted. Mizabi et al is cite to show additional types of gaskets and process of obtaining the gaskets...,especially at the figures and their descriptions and co.1:15 to 2:6 and 43 to 57, 3:42 to 4:3, 12:23-43, 45:1-7. Since the above references are related to an electrochemical power and gaskets, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite or include the known gaskets and their function for the advantage as disclosed, taught and suggested in the secondary references.

XV. The references to be in line for applied could be Kawamura (5,684,110), Sato et al (5,985,4800, Higuchi et al (6,051,097) and Wengrovius (6,057,405).

Art Unit: 1752

XVI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:00 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385. The fax phone numbers of the examiner is 571- 273-1332. Since there is a newly electronic filing procedure for all initial communicating papers and all responses to an Office action, the examiner fax phone number is not for use to receive any fax in response to an Office action. Applicant is requested and required to send all initial communicating papers and all response to Office action to a central paper or fax receiving center for an electronic scanning procedure.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

(2) mail with a central mail receiving address:

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Application/Control Number: 10/030,076

Page 11

Art Unit: 1752

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
13 February 2004

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le